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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08 484,838	06/07/1995	STEVEN F. FABIJANSKI	33229-324-PI	4954

27310 7590 03/19/2003

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EXAMINER

FOX, DAVID T

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 03/19/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
08/484,838

Applicant(s)  
Fabjanski et al

Examiner  
Fox

Group Art Unit  
1638

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 12/26/02
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 13-16 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 13-16 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).
- \*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892 \_\_\_\_\_ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 \_\_\_\_\_ Other \_\_\_\_\_

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicants' amendments of 26 December 2002 have obviated all rejections of record except as indicated below.

Amended claim 13 is objected to under 37 CFR 1.121(c) as being in improper amended format. Specifically, in part (a)(iii), line 2, bracketed material appears in the clean copy of the amendment. In the interest of compact prosecution, the claim has been treated on the merits. Such treatment does not relieve Applicants of the responsibility to respond to this objection.

Claims 15-16 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,013,859. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons presented on page 4 of the last Office action for claims 4, 9-12 and 15-16.

Claims 13-16 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32, 34, 42, 45, 48, 71, 82-87, 90-91 and 93-94(a)(iv) of copending Application No. 08/359,938. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons presented in the last Office action on pages 4-5 for claims 3-4 and 9-16.

Claims 13-16 remain deemed free of the prior art, as stated previously for claims 3-4 and 12-16.

No claim is allowed.

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Applicants' arguments filed 26 December 2002 have been fully considered but they are not persuasive. Applicants urge that the obviousness-type double patenting rejections are improper, given the failure of the claims of the patent or copending application to teach or suggest the use of a 3' untranslated terminator signal sequence in the recombinant DNA molecule.

The Examiner maintains that Applicants are being disingenuous. The requirement of a 3' untranslated terminator signal sequence is well-known in the art. Such a sequence appears in a multitude of native genes, in order to prevent unlimited run-on transcription, and in order to facilitate the production of discrete transcripts which can be translated into finite peptides. Such a 3' untranslated terminator signal sequence has been widely used in the genetic engineering art in constructing recombinant DNA molecules for transcription into sense or antisense transcripts, for the ultimate translation of the former into desired peptides. Furthermore, Applicants' specification demonstrates the state of the art in its admission that 3' untranslated terminator signal sequences are present in native genes (see, e.g., page 17 of the specification, lines 1-5), and in its admission that 3' untranslated terminator signal sequences should be inserted into recombinant DNA molecules in sense and antisense constructs (see, e.g., page 34 of the specification, line 35 through page 35, line 26; page 58 of the specification, lines 29-36). These admissions also appear in the specifications of the patent (see, e.g., column 10, lines 56-62; column 19, lines 21-27; column 52, lines 41-45) and of the copending application.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (703) 306-3218. The fax phone number for this Group is (703) 872-9306. The after final fax phone number is (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

March 17, 2003

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 1638

